

REMARKS/ARGUMENTS

Claims 1-6, 8, 9, 11, 13-17, 20 and 21 are pending in this application. Claims 1, 9, 20 and 21 are independent. Claims 1, 9, 11, 13-17 and 20 are amended. New claim 21 is added. Claims 7, 10, 12, 18 and 19 are cancelled without prejudice to, or disclaimer of, the subject matter recited therein.

On page 2, the Office Action advises that claims 18 and 19 will be objected to under 37 C.F.R. § 1.75 if claims 11 and 12 are allowed. Claims 18 and 19 are cancelled without prejudice to, or disclaimer of, the subject matter therein. Therefore, Applicant respectfully requests that the advisory comment regarding double patenting on page 2 of the Office Action be withdrawn.

On pages 2-5 the Office Action rejects claims 1-5, 10 and 13-16 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,756,997 to Ward III et al. (hereinafter "Ward"). This rejection respectfully traversed.

Claim 1, from which claims 2-5 depend is amended to incorporate the subject matter previously recited in dependent claim 7. On page 9, the Office Action correctly concedes that Ward fails to disclose, teach or suggest subject matter previously recited in dependent 7.

Claim 21, from which claims 13-16 depend, corresponds to claim 1 plus the subject matter recited in claim 8. In the Office Action, Ward is not applied in rejecting claim 8. Applicant respectfully submits that the Office Action's decision not to apply Ward in rejecting claim 8 was correct for the reason that Ward does not disclose, teach or suggest subject matter recited in claim 8, now incorporated in claim 21, which claims 13-16 depend.

Claim 10 is cancelled without prejudice to, or disclaimer of, the subject matter therein.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-5, 10 and 13-16 as being allegedly anticipated by Ward be withdrawn.

On pages 6-7, the Office Action rejects claims 1 and 10 as allegedly being anticipated by U.S. Patent No. 5,940,073 to Klosterman et al. (hereinafter "Klosterman"). This rejection is respectfully traversed.

Claim 10 is cancelled without prejudice to, or disclaimer of, the subject matter therein. Claim 1 is amended to incorporate the subject matter previously recited in dependent claim 7. The Office Action does not apply Klosterman in rejecting dependent claim 7. Applicant respectfully submits that the Office Action's decision not to apply Klosterman in rejecting claim 7 was correct for the reason that Klosterman does disclose, teach or suggest the subject matter recited therein.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1 and 10 as allegedly being anticipated by Klosterman be withdrawn.

On pages 7-9, the Office Action rejects claims 6 and 17 under 35 U.S.C § 103(a) as allegedly being unpatentable over Ward in view of U.S. Patent No. 6,240,555 to Shoff et al. (hereinafter "Shoff"). This rejection is respectfully traversed.

Claim 6 depends from claim 1. Claim 1 is amended to incorporate subject matter previously recited in claim 7. On page 9 in connection with the rejection of claim 7, the Office Action correctly concedes that Ward fails to disclose, teach or suggest subject matter recited therein. Shoff was not applied in rejecting claim 7. Applicant respectfully asserts that the Office

Action's decision not to apply Shoff in rejecting claim 7 was correct for the reason that Shoff does not disclose, teach or suggest the subject matter recited therein.

Claim 17 is amended to depend from new claim 21. New claim 21 corresponds to the original independent claim 1 plus the subject matter recited in dependent claim 8. On page 10, in connection with the rejection of claim 8, the Office Action correctly concedes that Shoff fails to disclose, teach or suggest subject matter recited in claim 8. Ward is not applied in rejecting claim 8. Applicant respectfully submits that the Office Action's decision not to apply Ward in rejecting claim 8 was correct for the reason that Ward does not disclose, teach or suggest the subject matter recited therein.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 6 and 17 on pages 7-9 of the Office Action be withdrawn.

Claim 9 is amended to correspond to previous claim 6 rewritten in independent form. The rejection of claim 6 as allegedly being unpatentable over Ward in view of Shoff is respectfully traversed with respect to claim 9 for at least the following reasons.

Claim 9 recites "events" several times according to the combination recited therein. With respect to this subject matter, the Office Action cites column 5, lines 60-64 of Shoff and Figure 3 depicting the "target specifications" referred to therein. Specifically, the "target specifications" disclosed in Shoff are the title, actor, network, time, stereo, and close captioning. None of the "target specifications" disclosed, taught, or suggested in Fig. 3 of Shoff correspond to events as recited in claim 9.

Further, it is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according the precise combination including certain elements and excluding certain others as necessary to achieve the subject matter according to the combinations recited in the rejected claims.

With respect to alleged motivation to combine the respected teaching of Shoff and Ward, the Office Action refers to column 1, lines 32-35 of Shoff. See the paragraph bridging pages 8 and 9 of the Office Action. However, the cited portion of Shoff only establishes a motivation to provide interactive programming content in general. In other words, the alleged motivation to combine certain specific teachings of Ward and Shoff to the exclusion of other teachings in Ward and Shoff in order to arrive at the subject matter previously recited in claim 6 and now recited in claim 9, the Office Action cites a motivation for nothing more than the entire broad field of interactive programming to which all of the claims pertain. Applicant respectfully

submits that this alleged motivation is insufficient to satisfy the motivation required to arrive at the specific combination recited in claim 9.

On pages 9-10 the Office Action rejects claims 7, 11 and 18 under 35 U.S.C § 103(a) as allegedly being unpatentable over Ward in view of U.S. Patent No. 6,263,507 to Ahmad et al. (hereinafter "Ahmad"). This rejection is respectfully traversed.

Claims 7 and 18 are canceled without prejudice to, or disclaimer of, the subject matter recited therein. Claim 11 is amended to depend from new claim 21. New claim 21 incorporates subject matter previously recited in claim 8. Neither Ward nor Ahmad is applied in the rejection of claim 8 on pages 10-11 of the Office Action. Applicant respectfully submits that the Office Action's decision not to apply either Ward or Ahmad in rejecting claim 8 was correct for the reason that neither Ward nor Ahmad disclose, teach or suggest the subject matter according to the combination recited in claim 8.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 7, 11 and 18 as allegedly being unpatentable over Ward in view of Ahmad be withdrawn.

Claim 1 is amended to incorporate the subject matter previously recited in claim 7. It is respectfully submitted that claim 1 is allowable over the combination of Ward and Ahmad for at least the following reasons.

Claim 1 recites "summaries" according to the combination therein. On page 9, the Office Action correctly concedes that Ward does not disclose, teach or suggest this subject matter. In order to overcome this admitted deficiency in Ward, the Office Action relies on Ahmad. However, none of the disclosure, teaching or suggestions in Ahmad pertains to summaries of

episodes. Rather, even assuming, *arguendo*, that the broadcast disclosed in Ahmad correspond to episodes as recited in claim 1, Ahmad only pertains to segments of news broadcasts or entire news broadcasts, but never a summary of either a segment or a summary of an entire news broadcast. Further, it is respectfully submitted that the specification makes clear that a news broadcast is outside scope of an episode of a television program as that term is defined according to claim 1.

On pages 10-11, the Office Action rejects claims 8, 12 and 19 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Klosterman in view of Shoff and further in view of U.S. Patent No. 6,757,482 to Ochiai et al. (hereinafter Ochiai"). This rejection is respectfully traversed.

Claim 12 and 19 are cancelled with prejudice to, or disclaimer of, the subject matter recited therein. Claim 1, from which claim 8 depends, is amended to incorporate the subject matter previously recited in claim 7. Neither Klosterman nor Shoff nor Ochiai are applied in the rejection of claim 7 in the Office Action. Applicant respectfully submits that the Office Action's decision to exclude Klosterman, Shoff and Ochiai from the rejection of claim 7 was correct for the reason that neither Klosterman, nor Shoff nor Ochiai disclose, teach or suggest the subject matter recited therein.

For at least the foregoing reasons, it is respectfully requested that the rejection claims 8, 12 and 19 as allegedly being unpatentable over Klosterman in view of Shoff and Ochiai be withdrawn.

New claim 21 corresponds to claim 8 rewritten in independent form. It is respectfully submitted that new claim 21 is patentable over Klosterman in view of Shoff and Ochiai for at least the following reasons.

Claim 21 recites "other episodes similar to an event in the television program being watched" (emphasis added). With respect to this subject matter, the Office Action alleges that, "Shoff teaches a video clip related to the program being watched" (emphasis added). Presumably the Office Action intended to use the words "related to" correspond to the words "similar to" recited in claim 8 and now in claim 21. However, there is no indication whatsoever that any of the video clips disclosed, taught, or suggested in Shoff are "related to" the television program being watched as recited in claim 21.

Further, claim 21 recites, "displaying the information along with the television program being watched" (emphasis added). In other words, the video clip is displayed at the same time as television program. With respect to, "combining video clips of events in other episodes" recited in claim 21, the Office Action relies on Ochiai. See Office Action page 11, first paragraph. However, Ochiai expressly teaches away from displaying a video clip according to the combination recited in claim 21 "along with" the television program being watched as recited. Rather, Ochiai teaches a serial display of the video clips, one after the other. See column 10, lines 7-13.

For at least the foregoing reasons, it is respectfully submitted that new claim 21 is patentable over Klosterman in view of Shoff and Ochiai.

On pages 11-13, the Office Action rejects claims 9 and 20 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Publication No. 2001/0018771 to Walker et al. (hereinafter "Walker") in view of U.S. Patent No. 6,789,106 to Eyer et al. (hereinafter "Eyer"). This rejection is respectfully traversed.

Claim 9 is amended to correspond to original claim 6 rewritten in independent form. Neither Walker nor Eyer are part of the rejection of claim 6 in the Office Action. Applicant respectfully submits that the Office Action's decision not to apply either Walker or Eyer in rejecting claim 6 was correct for the reason that neither Walker nor Eyer disclose, teach or suggest the subject matter recited therein.

Claim 20 is amended to incorporate subject matter previously recited in claim 11. Neither Eyer nor Walker are applied in the rejection of claim 11 in the Office Action. It is respectfully submitted that the Office Action's decision not to apply either Eyer or Walker in the rejection of claim 11 was correct for the reason that neither Walker nor Eyer disclose, teach or suggest the subject matter recited therein.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 9 and 20 as allegedly being unpatentable over Walker in view of Eyer be withdrawn.

Further regarding claim 9, it is respectfully submitted that the claim is allowable over the combination of Walker and Shoff for the reasons stated above in connection with the rejection of claim 6 as allegedly being unpatentable over Walker in view of Shoff. Further regarding claim 20, it is respectfully submitted that the claim is allowable over the combination of Ward in view Ahmad for the reasons stated above in connection of the rejection of claim 11 as being allegedly

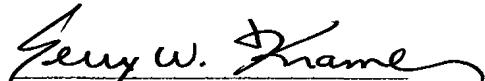
being unpatentable over Ward in view of Ahmad. Still further regarding claim 20, it is respectfully submitted that the claim is patentable over the combination of Ward in view Ahmad for the reason stated above in connection with claim 1, incorporating subject matter previously recited in claim 7 and similar to the subject matter recited in claim 11, now incorporated in claim 20.

CONCLUSION

While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the Yan Glickberg in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
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